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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte UWE SYDON, OLAF DICKER, and JUERGEN KOCKMANN

Appeal 2009-005404
Application 09/754,905[1]
Technology Center 2400

Before MARC S. HOFF, CAROLYN D. THOMAS,
and ELENI MANTIS MERCADER, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL[2]

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[1] The real party in interest is Siemens Communications, Inc.

[2] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-3 and 6-34. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention relates to a cordless communication system that provides optimum spectral usage for wireless devices by enabling direct communication between devices within the wireless network, wherein synchronization occurs between the wireless devices using the dedicated communication channel established by the base station (Spec. 6:5-10, 6:25-7:13).

Claim 1 is exemplary:

1. A cordless communication system, comprising:
a central unit; and
at-least two remote units capable of radio frequency communication with said central unit and other of said at least two remote units, a first of said at least two remote units being capable of providing a request to said central unit for a direct connection with a second of said at least two remote units;
wherein said central unit is capable of assigning a dedicated communication channel for enabling direct communication between selected ones of said at least two remote units upon receiving a request from said first remote unit, said central unit assigning a dedicated communication channel for enabling direct communication between said first and second remote units, said second remote unit synchronizing to said first remote unit.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Miyake	5,903,618	May 11, 1999
Morvan	6,574,452 B1	Jun. 3, 2003

Claims 11-27 and 30-34 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1-3, 6-10, and 28-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Miyake.

Claims 11-27 and 30-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyake in view of Morvan.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Appeal Brief (filed December 8, 2005) and the Examiner's Answer (mailed February 22, 2006) for their respective details.

ISSUES

With respect to the rejection under § 112, Appellants contend that the Specification has provided adequate disclosure that once the central unit establishes direct communication between the first and second remote units, information communicated between the first and second remote units is not communicated through the central unit but through the dedicated communication channel (App. Br. 6-7).

With respect to the § 102 rejection, Appellants argue that independent claim 1 recites that the second remote unit synchronizes to the first remote unit during direct communication with the first remote unit through the dedicated radio frequency connection (App. Br. 7). In contrast, Appellants assert that Miyake discloses that all terminals of the system always synchronize to the base station through sync signals paged from the base station, even during direct communication between the terminals (App. Br. 7).

Finally, with respect to the § 103 rejection, Appellants assert that Morvan fails to disclose teach or suggest a central unit or base station that assigns the dedicated radio frequency, since Morvan discloses that the base station simply passes a message from the requesting communication device when a direct connection between two of the communication devices is desired (App. Br. 9).

Appellants' contentions present us with the following three issues:

1. Does the Specification provide adequate support for synchronization on the assigned dedicated communication channel?

2. Does Miyake disclose a central unit that assigns a dedicated communication channel for enabling direct communication between a first and second remote unit, wherein the second remote unit synchronizes to the first remote unit?

3. Do the references disclose that the second remote unit synchronizes to the first remote unit using the dedicated communication channel?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

The Invention

1. After remote unit 14 provides a request to the central unit 12 using communication channel "a" for direct communication to remote unit 16, central unit 12 initiates the dedicated wireless channel "f" between the first remote unit 14 and the second remote unit 16. The remote units, 14 and 16, communicate directly on wireless channel "f," wherein the "requesting" remote unit 14 functions as a "temporary central unit" such that the second

remote unit 16 synchronizes to the first unit 14. When communication between the first and second remote units 14 and 16 ceases, either remote unit may communicate to the central unit 12 the fact that direct communication between the remote units 14 and 16 has ended. Upon this notification, central unit 12 terminates the direct communication channel "f". The first and second remote units, 14 and 16, return to their original state, wherein each synchronizes to the central unit 12 (Figs. 1 and 2; Spec. 6:2-10; 6:25-7:13).

Miyake

2. Miyake discloses a multimode radio communication system, including a base station connected to a wire communication network, capable of terminal-to-terminal communication, i.e., peer-to-peer communication, performed without using any infrastructure equipment. The base station wirelessly transmits a sync signal to the radio communication terminals, wherein the terminals are operated in synchronization with the sync signal transmitted from the base station. A terminal may communicate with another terminal directly or indirectly through the base station. The terminal includes a means for receiving a sync signal transmitted from the base station and a means for directly communicating with another radio communication terminal by a peer-to-peer communication link in synchronization with the sync signal without using the base station (Figs. 8, 10, and 11; col. 2, ll. 5-10 and 29-48; col. 9, ll. 19-42). During peer-to-peer communication, however, the terminals receive a sync signal transmitted from the base station (col. 8, ll. 35-49).

Morvan

3. Morvan discloses a method and system including terminals 4102 and 4103 that may communicate in confidential mode. When the first terminal 4102 desires to set up confidential communication with device 4103, device 4102 sends a message 4503 which passes, transparently, through the base station 4101. Device 4103 accepts or rejects the confidential communication request by sending message 4504 back to device 4102. After the connection through the base station 4101 is closed, device 4102 automatically switches into base station operating mode, wherein device 4102 functions in the role of the "new base station." Device 4103 starts a procedure for synchronizing itself with the new base station 4102, after having performed a detachment procedure with the base station 4101. When device 4103 is synchronized with the communication device 4102, confidential communication may commence (col. 41, ll. 5-39).

PRINCIPLES OF LAW

Enablement

Pursuant to 35 U.S.C. § 112, first paragraph, "[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988).

Anticipation

Anticipation pursuant to 35 U.S.C § 102 is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v.*

IRECO Inc., 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994). Limitations found in the Specification are not to be read into the claims. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Claims are to given their broadest reasonable interpretation. *Id.*

Obviousness

On the issue of obviousness, the Supreme Court has stated that "the obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Further, the Court stated "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416.

ANALYSIS

Rejection of claims 11-27 and 30-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement

Independent claims 11 and 20 recite that the second remote unit synchronizes "to said first remote unit during communication with said first remote unit via the dedicated radio frequency connection." Independent claim 32 recites a similar claim limitation: "the first remote unit functioning as a temporary central unit for the second remote unit during direct communication between the first remote unit and the second remote unit so that the second remote unit synchronizes to the first remote unit."

We consider Appellants' arguments to be persuasive to show Examiner error. Specifically, we do not agree with the Examiner's finding that the Specification does not disclose that the first and second remote unit exchanges the synchronized message using the assigned channel (Ans. 3; FF 1).

We agree, however, with Appellants that the Specification does provide adequate disclosure to support the claim limitation (App. Br. 6-7). Specifically, the Specification discloses that after remote unit 14 provides a request to the central unit 12 using communication channel "a" for direct communication to remote unit 16, central unit 12 initiates the dedicated wireless channel "f" between the first remote unit 14 and the second remote unit 16 (FF 1). Further, the Specification discloses that the remote units, 14 and 16, communicate directly on wireless channel "f," wherein the "requesting" remote unit 14 functions as a "temporary central unit" such that the second remote unit 16 synchronizes to the first unit 14 (FF 1). We find that this recitation provides adequate support for the claim limitation at issue.

Therefore, because Appellants' arguments have persuaded us of error in the Examiner's rejection of independent claims 11, 20, and 32 and that of dependent claims 12-19, 21-27, 30, 31, 33, and 34 under 35 U.S.C. § 112, first paragraph, we reverse the Examiner's rejection.

Rejection of claims 1-3, 6-10, and 28-29 under 35 U.S.C. § 102(b) as being anticipated by Miyake

We select claim 1 as representative of this group of claims, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).

Representative claim 1 recites "wherein said central unit is capable of assigning a dedicated communication channel for enabling direct communication between selected ones of said at least two remote units upon receiving a request from said first remote unit, said central unit assigning a dedicated communication channel for enabling direct communication

between said first and second remote units, said second remote unit synchronizing to said first remote unit."

We do not consider Appellants' arguments to be persuasive to show Examiner error. Specifically, we agree with the Examiner that Appellants' argument that claim 1 recites that the second remote unit *synchronizes* to the first remote unit *during direct communication* with the first remote unit *through the dedicated radio frequency connection* is not commensurate with the scope of the claim, since the claim limitations recited by Appellants are not found within the claim limitation at issue (App. Br. 7, Ans. 10). Representative claim 1 recites the "second remote unit synchronizing to said first remote unit." The claim does not recite how or when the synchronization occurs. The claim is silent as to synchronization "during direct communication" as asserted by Appellants (App. Br. 7).

Further, Miyake discloses that synchronization occurs between the central unit and each remote unit continuously using a sync signal, wherein the base station wirelessly transmits a sync signal to each radio communication terminal (FF 2). Each terminal includes a means for receiving a sync signal transmitted from the base station and a means for directly communicating with another radio communication terminal by a peer-to-peer communication link *in synchronization with the sync signal without using the base station* (FF 2 (emphasis added)). Thus, each terminal may be synchronized during a peer-to-peer communication session as required by the claim.

We find that Miyake discloses the claimed "second remote unit synchronizing to said first remote unit." As a result, we will sustain the

Examiner's § 102 rejection of representative claim 1 and that of dependent claims 2-3, 6-10, and 28-29.

Rejection of claims 11-27 and 30-34 under 35 U.S.C. § 103(a) as being anticipated by Miyake

We select claim 11 as representative of this group of claims, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).

Representative claim 11 recites "wherein a first of said at least two remote units is further capable of communication with a second of said at least two remote units via a dedicated radio frequency connection assigned by said central unit for enabling direct communication between said first remote unit and said second remote unit, the second remote unit synchronizing to said first remote unit during communication with said first remote unit via the dedicated radio frequency connection." Independent claims 20 and 32 are similar in scope to representative claim 11.

We do not consider Appellants' arguments to be persuasive to show Examiner error. Specifically, we agree with the Examiner's finding that, although Miyake fails to disclose the remote units performing synchronization on an assigned dedicated communication channel during peer-to-peer communication, Morvan does disclose that the mobile terminals are synchronized on the assigned dedicated communication channel during peer-to-peer communication (Ans. 11). More particularly, Morvan discloses that a first and second communication device, 4102 and 4103, may communicate in confidential mode, wherein device 4102 automatically switches into base station operating mode (FF 3). In base station operating mode, device 4102 operates as a "new base station" after an assigned

communication channel is established (FF 3). Morvan further discloses that device 4103 starts a procedure for synchronizing itself with the "new base station" 4102, after having performed a detachment procedure with the base station (FF 3).

Therefore, we find that the Examiner has established the prima facie obviousness of the claims, because the combination of Miyake and Morvan discloses a cordless communication system that includes remote units that are able to communicate directly with each other through an assigned dedicated communication channel, wherein the units synchronize with each other on the dedicated communication channel. As a result, we will sustain the Examiner's § 103 rejection of representative claim 11, and that of independent claims 20 and 32 and dependent claims 12-19, 21-27, 30-31, and 33-34.

CONCLUSIONS OF LAW

The Specification provides adequate support for synchronization on the assigned dedicated communication channel.

Miyake discloses a central unit that assigns a dedicated communication channel for enabling direct communication between a first and second remote unit, wherein the second remote unit synchronizes to the first remote unit.

The references disclose that the second remote unit synchronizes to the first remote unit using the dedicated communication channel.

ORDER

The Examiner's rejection of claims 11-27 and 30-34 under 35 U.S.C. § 112, first paragraph is reversed.

The Examiner's rejection of claims 1-3, 6-10, 28, and 29 under 35 U.S.C. § 102 is affirmed.

The Examiner's rejection of claims 11-27 and 30-34 under 35 U.S.C. § 103 is affirmed.

Since at least one rejection encompassing all claims on appeal is affirmed, the decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

ELD

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